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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,135	10/13/1999	KATSUHITO MIURA	P63943USO	7013

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EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

9

DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=9

Office Action Summary

Application No.

09/417,135

Applicant(s)

MIURA ET AL.

Examiner

Mercado A Julian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Remarks

This Office Action is responsive to Applicant's amendment filed December 17, 2001.

The rejection of claims 3-7 under 35 U.S.C. 112, second paragraph, is withdrawn. As Applicant has pointed out, the rejection should have more properly been applied against claim 6. However, a rejection of claim 6 under the same grounds is deemed moot in view of Applicant's cancellation of this claim in favor of new claim 18.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 and 7-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Miura *et al* (U.S. Pat. 5,968,681).

Miura has been discussed in the previous Office Action. The rejection is maintained for the reasons of record and is herein reiterated. Miura teaches a repeating unit derived from propylene oxide [I], a repeating unit copolymer derived from ethylene oxide [II], and monomers [III] and [IV] of the instant formulas (III-1) and (III-2). The examiner further notes that the claimed range of 3 to 30% by mol of a repeating unit derived from propylene oxide is anticipated

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by Miura within the scope of the overlapping range of 5 to 30%, as Miura specifically discloses a range of 5 to 95%.

Applicant's arguments have been fully considered, however they are not persuasive.

Applicant alleges that in contrast to Miura's invention, the claimed invention constitutes repeating units derived from propylene oxide in the backbone or *main chain*. [emphasis in original]. This argument is not persuasive. The scope of the present claims are silent as to a limitation drawn to the repeating units derived in the backbone or main chain of the polymer. This line of argument is outside the scope of the present claims.

Applicant further submits that such a repeating unit within the backbone or main chain of the monomer is a "readily apparent feature" of the claimed invention. The lack of this feature within the scope of the present claims notwithstanding, to the contrary the examiner finds this feature far from "readily apparent". For example, on page 3 of Applicant's specification, it appears to the examiner that the repeating unit derived from propylene oxide can reside as a side chain from the monomer.

Double Patenting

Claims 1-5 and 7-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 5,968,681 to Miura *et al.* As discussed in the previous Office Action, although the conflicting claims are not identical, they are not patentably distinct from each other because the instant weight percentages

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of each of the monomers in the electrolyte (outside of the 5 to 30% range anticipated by Miura) would have been obvious to the skilled artisan for reasons such as optimization of ionic conductivity.

Applicant's arguments have been fully considered, however they are not persuasive.

As discussed above, Applicant submits that the claimed invention is in contrast to Miura's invention, due in part to the repeating units allegedly being derived from the backbone or main chain of propylene oxide. This argument is not persuasive and is considered outside the scope of the present claims for the reasons already discussed. The scope of the present claims are silent as to a limitation drawn to the repeating units being derived in the backbone or main chain of the polymer.

In response to the examiner's reasoning for optimization of the weight percentages of the monomers, Applicant requested evidence of the examiner's position. This evidence can be found in Miura at column 4 line 40 *et seq.* Note that the mol percentages of the monomers are specifically disclosed to require optimization. For example, the polymerization degree n of the propylene oxide unit is optimized within the range of 1 to 12, so that the polymerization degree can result in a favorable ionic conductivity within the solid electrolyte.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Conclusion

The prior art relied upon in this Office Action will not be provided since it is the same prior art made of record in the previous Office Action.

Acknowledgment is made of Applicant's filing of a supplementary IDS on December 17, 2001. However, the documents cited in this IDS could not be considered by the examiner as they appear to be absent from the file. The examiner will consider these documents upon submission of copies thereof.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

A handwritten signature in black ink, consisting of a large loop followed by a series of smaller, connected loops.

January/February 28, 2002

A handwritten signature in black ink, featuring a large, stylized 'S' followed by several sharp, angular strokes.

STEPHEN KALAFUT
PRIMARY EXAMINER
GROUP 1700